

### **REMARKS**

The pending Office Action addresses and rejects claims 1-4 and 6-26. Applicants respectfully request reconsideration in view of the amendments and remarks submitted herein.

#### ***Amendments to the Claims***

Claim 1 is amended to correct a typographical error. Claims 18 and 21 are amended to include the limitations of claim 22, which is now cancelled.

No new matter is added.

#### ***Objection to the Specification***

The Examiner requests that the trademark BOOKWALTER<sup>TM</sup> be accompanied by its generic terminology in the specification. The generic terminology for the trademark BOOKWALTER<sup>TM</sup> is “surgical retractor,” which currently appears with the trademark on page 6, paragraph 1 of the specification. Withdrawal of this objection is respectfully requested.

#### ***Claim Rejections Pursuant to 35 U.S.C. §102***

##### **U.S. Patent No. 3,626,471 of Florin**

Claims 18-20 stand rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,626,471 of Florin.

Independent claim 18 recites a tissue retractor and drill guide kit that includes at least one tissue retractor and guide device having a guide member with at least one barrel defining a lumen for receiving a tool, and an elongate member having a proximal handle portion and a distal tissue-retracting portion that extends a distance beyond a distal-most end of the guide member to form an extension portion. At least one of the guide member and the elongate member is adapted to couple to a spinal implant. The kit also includes a cross member (50) that is adapted to removably connect two tissue retractor and guide devices (10a, 10b). The Examiner continues to argue that Florin discloses a device (10) having an elongate member with two lumens and a substantially planar surface (11) capable of retracting tissue, and a cross member (23 or 21) capable of serving as connection points

for connecting two retractors. With regard to the functional language in claim 18, the Examiner comments that:

a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.*

(Office Action dated August 18, 2006, p. 5.)

Florin fails to teach or even suggest a cross member that is capable of removably connecting two tissue retractor and guide devices. Florin discloses a single device (10) which has a retractor blade (11) with two tubes (13, 14) disposed thereon, and a fiber optic element (21) that extends along the retractor blade between the two tubes. The device also includes axially spaced clips (22, 23) that are designed to hold the fiber optic element (21) in position. The Examiner asserts that these clips may be capable of connecting two retractor devices. Neither the clips (22, 23) nor the fiber optic element (21), however, have any sort of mating feature that would allow them to mate to another retractor device. To the contrary, the axial clips (22, 23) appear to be fixedly attached to the blade (11) and hold the fiber optic element (21) in position. Florin does not disclose a cross-connector that is capable of connecting two retractor devices, and therefore claim 18, as well as claims 19-20 which depend therefrom, clearly distinguish over Florin and represent allowable subject matter.

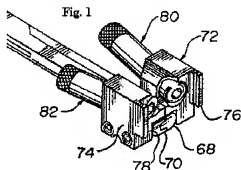
U.S. Patent No. 5,676,666 of Oxland et al.

Claims 18-24 stand rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,676,666 of Oxland et al. ("Oxland"). The Examiner continues to argue that Figure 1 of Oxland illustrates a device having an elongate member (62) with planar retracting surfaces (72, 74), and removable guide members (80, 82) with lumens therethrough. In addition, the Examiner argues that the hinge of the device constitutes a cross member.

As noted above, independent claim 18 recites a tissue retractor and drill guide kit that includes at least one tissue retractor and guide device having a guide member with at least one barrel defining a lumen for receiving a tool, and an elongate member having a proximal handle portion and a distal tissue-retracting portion that extends a distance beyond a distal-most end of the guide

member to form an extension portion which is adapted to rest against an outer edge of a spinal implant. Similarly, independent claim 21 recites a spinal fixation kit that includes an elongate member whose distal-most end extends a distance beyond a distal-most end of a guide member to form an extension portion that is adapted to rest against an outer edge of a spinal fixation plate to align the guide member with the spinal fixation plate.

Oxland generally discloses an installation device (62) with a single elongate member having two blades (68, 70). A guide head (72, 74) is attached to the blades of the elongate member with guide cylinders (80, 82) disposed therein. As shown in Figure 1 of Oxland, which is reproduced herein, the distal end of each blade (68, 70), i.e., an elongate member, is enclosed on three sides by the guide head (72, 74) and sits at a position that is recessed from the distal-most end of the guide head. Thus, Oxland does not disclose an elongate member having a distal end that extends past the distal-most end of the guide head so as to allow it to rest against a spinal fixation plate, as required by claims 18 and 21. The only portion of the device that extends past a distal-most end of the guide member are the tabs (76, 78). The tabs (76, 78), however, are not formed on a distal end of an elongate member, as required by claims 18 and 21, but rather they extend from the guide head. Since Oxland doesn't teach an elongate member that extends a distance beyond a distal-most end of the guide member to form an extension portion that is adapted to rest against an outer edge of the spinal fixation plate, Oxland cannot anticipate claims 18 and 21, and thus claims 18 and 21, as well as claims 19-20 and 23-24 which depend therefrom, distinguish over Oxland.



***Claim Rejections Pursuant to 35 U.S.C. §103***

***(a) Claims 1-4 and 6-17***

Claims 1-4 and 6-17 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Oxland in view of U.S. Patent No. 4,686,972 of Kurland. The Examiner continues to argue that Oxland discloses the claimed invention except that it fails to teach an elongate member having a distal-most

end surface that is substantially concave. Thus, the Examiner relies on Kurland to disclose a drill guide (10) having concave ends (6) to facilitate proper seating on the drilling target. The Examiner submits that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the device of Oxland with a concave end as taught by Kurland "in order to facilitate proper seating on a drilling target and improve the procedure." Applicants respectfully disagree.

As discussed above, a distal-most end of the blades (68, 70) of Oxland are surrounded on three sides by a guide head (72, 74) and they sit at a position which is recessed from the distal end of the guide head. As a result, the distal end of the blades, i.e., the elongate member, cannot be positioned against a vertebral body and thus no person having ordinary skill in the art would be motivated to modify the distal end surface of the blades to be concave as taught by Kurland.

A person having ordinary skill in the art would also have no motivation to modify Oxland in view of Kurland because these devices are entirely distinct. Kurland is designed so that the concave elongate member can sit on and grip a bony surface. The device of Oxland is not designed to make contact with a bony surface at all, but instead is designed to mate with a drill plate. In fact, Oxland already provides opposing lips (76, 78), positioning rings (84, 86), and a forceps locking mechanism in order to facilitate and assure proper seating on a drill plate. Therefore, claim 1, as well as claims 2-4 and 6-17 which depend therefrom, distinguish over Oxland and Kurland, taken alone or combined, and represent allowable subject matter.

*(b) Claims 25 and 26*

The Examiner rejects claims 25 and 26 pursuant to 35 U.S.C. §103(a) as being obvious over Oxland. Claims 25 and 26 depend from claim 21. Thus, for the same reasons previously discussed with respect to claim 21, claims 25 and 26 distinguish over Oxland and represent allowable subject matter.

*Conclusion*

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,



Lisa Adams, Reg. No. 44,238  
Attorney for Applicant(s)

Date: October 9, 2006

Nutter McClennen & Fish LLP  
World Trade Center West  
155 Seaport Boulevard  
Boston, MA 02210  
Tel: (617)439-2550  
Fax: (617)310-9550

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